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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,705	11/28/2001	Wolfgang Seifarth	SEIFARTH	4008

20151 7590 09/22/2005

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NEW YORK, NY 10118

EXAMINER

WHISENANT, ETHAN C

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

*S*UPPLEMENTAL
Office Action Summary

Application No.

10/009,705

Applicant(s)

SEIFARTH ET AL.

Examiner

Ethan Whisenant, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10, 11 and 23-25 is/are allowed.
- 6) ☒ Claim(s) 13-22 is/are rejected.
- 7) ☐ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 November 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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SUPPLEMENTAL NON-FINAL ACTION

1. This action is **Supplemental** to and replaces the Office Action mailed 31 MAY 05.

On 23 AUG 05 the examiner held a telephonic interview with the applicant's representative Ursula Day. During that interview the applicant's representative pointed out that a preliminary amendment had been filed in this application on 06 MAR 02 wherein Claims 1-9 had been canceled and new Claims 10-25 added. The examiner reported that no such Preliminary Amendment was of record. The applicant's representative agreed to FAX a copy of the Preliminary amendment and did so on 23 AUG 05. The Examiner agreed to consider the Preliminary Amendment and to prepare a Supplemental Office Action addressing **Claims 10-25**.

SEQUENCE RULES

2. This application now complies with the sequence rules and the sequences have been entered by the Scientific and Technical Information Center.

35 USC § 112- 2nd Paragraph

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

CLAIM REJECTIONS under 35 USC § 112- 2ND PARAGRAPH

4. **Claim(s) 13-22** is/are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 is indefinite because there is no nexus between the preamble and the claim steps. Claim 1 in its preamble direct to a method which is to accomplish a particular goal. However, none of the claim steps states that this goal is accomplished. For clarity, claimed methods should recite that the

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purpose of the method has been attained (i.e. provide a nexus between the preamble and the claim steps).

Claims 15 and 20 are confusing in light of the phrase "between one of." Because of this phrase, it is unclear as to what/where the RDBH probes correspond. This is in contrast to Claim 16 and 21, wherein the applicant uses only the word "between." Please note that the examiner considers Claims 16 and 21 to be clear and unambiguous (i.e. they comply with the requirements of 35 USC § 112-2nd Paragraph).

Claim 21 is indefinite in that it is dependent upon cancelled Claims 3 to 6.

35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that may form the basis for rejections set forth in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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CLAIM REJECTIONS UNDER 35 USC § 102

6. **Claim(s) 13, 15-22** is/are rejected under 35 U.S.C. 102(b) as being anticipated by Herrmann et al. (1994).

Herrmann et al. teach a method for the specific detection and identification of a retrovirus or retroviral nucleic acid in a specimen comprising all of the limitations recited in Claim 13, 15-22. See, at least, for example, the abstract and Figure 2 of Herrmann et al.

CLAIM OBJECTIONS

7. **Claim 12** is/are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The intended use does not further limit the MOP primer mixture of Claim 10.

8. **Claim(s) 14** is /are is objected to because it is dependent upon a rejected independent base claim, however, Claim 14 would appear to be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

REASON FOR ALLOWANCE

9. **Claims 10-11 and 23-25** is/are allowable over the prior art of record because the prior art considered does not teach or reasonably suggest the MOP primer mixtures recited in Claims 10 and 23. In particular, the closest prior art et al. Stuyver et al. [WO97/27332 (1997)] do not teach or reasonably suggest, either alone or in combination with the other prior art considered, the MOP primer mixtures recited in Claims 10 and 23.

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CONCLUSION

10. Claim(s) 10-11 and 23-25 is/are allowable while Claim(s) 12-22 is/are rejected and/or objected to for the reason(s) set forth above.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ethan Whisenant, Ph.D. whose telephone number is (571) 272-0754. The examiner can normally be reached Monday-Friday from 8:30AM -5:30PM EST or any time via voice mail. If repeated attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached at (571) 272-0745.

The Central Fax number for the USPTO is (571) 273-8300. Before faxing any papers, please inform the examiner to avoid lost papers. Please note that the faxing of papers must conform with the Notice to Comply published in the Official Gazette, 1096 OG 30 (November 15, 1989).



ETHAN WHISENANT
PRIMARY EXAMINER

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